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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,954	08/08/2001	Shell S. Simpson	1008230-1	2018
22879 7590 09/04/2007 HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400			EXAMINER BLACKWELL, JAMES H	
			ART UNIT 2176	PAPER NUMBER
			MAIL DATE 09/04/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/923,954

**Applicant(s)**

SIMPSON ET AL.

**Examiner**

James H. Blackwell

**Art Unit**

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5,8-12,14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,8-12,14 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This Office Action is in response to an amendment filed 06/05/2007.
2. The priority date is **08/08/2001**.
3. Claims 1-5, 8-12, 14, and 15 remain pending.
4. Claims 1, and 14-15 are independent claims.

### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 14 and 15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

#### ***Claim 14:***

Claim 14 recites a "*program product*" comprising "*computer readable code*" that "*create[s] a customized composition at an assembling web site.*" Accordingly, recited "*program product*" is software *per se*. Thus, the recited "*program product*" is not a process, a machine, a manufacture or a composition of matter.

Accordingly, Claim 14 fails to recite statutory subject matter as defined in 35 U.S.C. 101.

Art Unit: 2176

*Claim 15:*

Claim 15 recites a "*system*" comprising "*components*" that perform various functional steps for "*creating a customized composition at an assembling web site.*" The recited "*system*" is comprised merely of software components that perform the various functional steps. Accordingly, recited "*system*" is software *per se*. Thus, the recited "*system*" is not a process, a machine, a manufacture or a composition of matter.

Accordingly, Claim 15 fails to recite statutory subject matter as defined in 35 U.S.C. 101.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-5, 8-12, and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over LeMole et al. (U.S. Patent No. 6,009,410 filed 10/16/1997, issued 12/28/1999) in view of Timmer (U.S. Patent Application Publication No. 2002/0107895 filed 08/13/2001, published 08/08/2002).

**In regard to independent Claim 1, LeMole discloses:**

- *A method for creating a customized composition at an assembling web site* (Col. 2, lines 28-46 → a server that automatically (i.e., for each time a user logs into

the server via the web) produces composite advertising web pages based on user preferences), *comprising the steps of:*

- *providing a user interface configured to enable a user to input preference data* (Col. 4, lines 36-58; Fig. 2 → discloses a web user interface for specifying user preferences which are stored on the advertising server as a profile of the user);
- *automatically correlating the preference data to a plurality of different sources from which graphics related to the preference data are accessible* (Col. 4, line 47 through Col. 5, line 22 → discloses that a user provides preference information, and submits that information to the advertising server. The server then selects, based on the preference information (i.e., the profile), advertisers whose information correlates to the user's preferences, constructs an HTML-formatted page with hyperlinks to each advertiser's individual internet site). Note also that hyperlinks can be represented by graphics (see Col. 5, lines 2-3).
- *for each of the plurality of different sources of graphics, automatically obtaining a reference to a graphic related to the preference data that is accessible from that source* (Fig. 1; Col. 4, line 47 through Col. 5, line 22 → an HTML-formatted page is constructed with hyperlinks (references) to aggregated content (banner ads, graphics, video, etc.) from different web sites that correlate to what the user specified in their profile). Note that the

Art Unit: 2176

construction occurs whenever the user connects to the advertising web site (i.e., automatically).

- o *creating a custom composition that includes each obtained reference to a graphic* (Col. 4, line 47 through Col. 5, line 22 → a composition of hyperlinks is created and presented to the user).

LeMole fails to expressly disclose:

- o *creating a custom composition ... and information for positioning each referenced graphic on a sequence of pages generated by processing the composition.*

However, Timmer discloses *creating a custom composition ... and information for positioning each referenced graphic on a sequence of pages generated by processing the composition* (Pgs. 1-3, Paragraphs [0011], [0022] through [0026] → the invention allows a user to construct a personalized book (presumably multi-paged, see Pg.1 Paragraph [0011]) based on content that is supplied by the user directly, or via other means such as content tools (see Paragraph [0023]) or selected from any number of sources including the host, the host's plurality of content Partners, and third parties. In addition to content, the host also offers to the user the selection of structures (i.e., layout formatting) for their personalized book (see Paragraph [0022])). Thus, Timmer provides the means to generate a personalized book based on user and host provided content and layout/formatting.

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the disclosures of LeMole and Timmer since both inventions are related to the problem of creating/generating agglomerated content from a number of sources based on user provided inputs. Adding the disclosure of Timmer provides a means for laying out LeMole's agglomerated content onto a number of pages to create a personalized book.

**In regard to dependent Claim 2, LeMole discloses:**

- *the obtaining step comprises
  - *obtaining a reference to a graphic accessible from a different web site from the assembling web site (Col. 4, line 66 through Col. 5, line 3 → on the aggregate html-formatted web page are provided hyperlinks to each advertiser's individual site on the internet).**

**In regard to dependent Claim 3, LeMole discloses:**

- *at least one graphic is generated dynamically at the different web site, when the web site is accessed (Col. 4, lines 47-58 → targeted advertisement tailored/personalized for the individual based on their preferences).*

Since the advertisements are tailored/personalized for the individual user's preferences, it would have been obvious to one of ordinary skill in the art at the time of invention to have dynamically generated images, banners, video clips, etc. based on user preferences to provide the user with the most pertinent information.

**In regard to dependent Claim 4, LeMole discloses:**

- *each of a plurality of the different sources are on different web sites from said assembling web site (Fig. 1 → various web sites other than the CAR server with advertising content including images, graphics, video, etc.).*

**In regard to dependent Claim 5, LeMole discloses:**

- *the obtaining step comprises
  - *accessing at least two different web sites and retrieving information therefrom (Fig. 1; Col. 4, line 47 through Col. 5, line 22 → an HTML-formatted page is constructed with hyperlinks (references) to aggregated content (banner ads, graphics, video, etc.) from different web sites that correlate to what the user specified in their profile).**

**In regard to dependent Claim 8, LeMole fails to disclose:**

- *the custom composition designates a referenced graphic a position that is different relative to that of another referenced graphic.*

However, Timmer discloses *the custom composition designates a referenced graphic a position that is different relative to that of another referenced graphic* (Pg. 2, Paragraph [0022] → discloses the use of structures which define how the various agglomerated content are displayed/laid out/formatted to create the personalized book).



It would have been obvious to one of ordinary skill in the art at the time of invention to combine the disclosures of LeMole and Timmer since both inventions are related to the problem of creating/generating agglomerated content from a number of sources based on user provided inputs. Adding the disclosure of Timmer provides a means for laying out LeMole's agglomerated content onto a number of pages to create a personalized book.

**In regard to dependent Claim 9, LeMole discloses:**

- *at least one of the sources is a file* (Col. 2, lines 28-33 → advertising content can include static images, streaming banners, 3-D images, animation, video and/or audio clips. It was typical of such content, especially when provided by an advertiser to consist of both dynamic and static content. The latter of which was typically physically stored on the server as a file).

**In regard to dependent Claim 10, LeMole discloses:**

- *serving the composition to an imaging client* (Col. 1, lines 57-67 → composite advertising is served to a user's web client (which is interpreted as a form of imaging client since browsers were typically capable of at least displaying images).

**In regard to dependent Claim 11, LeMole fails to disclose:**

- *printing the composition.*

However, Timmer discloses *printing the composition* (Pg. 1, Paragraph [0012] → the [personalized] book may be saved and downloaded on a user's own computer, or, particularly if the amount of information becomes so great that it overwhelms an individual's storage capacity, may be saved to some other storage device, such as the host's server and storage facility. In addition, print options currently available for online publishing, are suitable if hard copies are preferred.

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the disclosures of LeMole and Timmer since both inventions are related to the problem of creating/generating agglomerated content from a number of sources based on user provided inputs. Adding the disclosure of Timmer provides a means for printing out LeMole's agglomerated content onto a number of pages to create a hard copy of a personalized book.

**In regard to dependent Claim 12, LeMole fails to disclose:**

- *sending the composition by email to a designated web site.*

However, it would have been obvious to one of ordinary skill in the art at the time of invention for a user of such an advertising aggregator to have instructed the site to periodically email advertisements to an address since such a feature and a request was typically possible of such advertising web sites at the time of invention providing the user the benefit of avoiding direct access to the advertising web site each time, for example, new content was available.

**In regard to Independent Claim 14**, Claim 14 merely recites a computer program for performing the method of Claim 1. Thus, the combination of LeMole and Timmer discloses every limitation of Claim 14, as indicated in the above rejection for Claim 1.

**In regard to Independent Claim 15**, Claim 15 merely recites a system for executing the method of Claim 1. Thus, the combination of LeMole and Timmer discloses every limitation of Claim 15, as indicated in the above rejection for Claim 1.

### ***Response to Arguments***

9. Applicants argue that the prior art of LeMole fails to disclose the limitation of Claims 1, 14, and 15 reciting *“creating a custom composition that includes each reference to a graphic and information for positioning each referenced graphic on a sequence of pages generated by processing the composition.”* Specifically, applicants argue that LeMole fails to disclose the creation of a “sequence of pages” and “information for positioning” graphics in the sequence of pages. The Examiner agrees with Applicant’s interpretation of LeMole’s “aggregate HTML-formatted page” with links to other pages as being a single “page” of content (see Pg. 6 of arguments). To disclose this limitation, the Examiner has introduced the prior art of Timmer. Timmer discloses the creation of a personalized book (appears to be a web log or “blog”) containing multiple pages into which content from a number of sources is placed according to a

Art Unit: 2176

"structure" (interpreted as a template), which defines the format/layout of the personalized book. Thus, Timmer in combination with LeMole discloses every limitation of Claim 1 (and similarly Claims 14 and 15).

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Blackwell whose telephone number is 571-272-4089. The examiner can normally be reached on 8-5 M-F.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on 571-272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 09/923,954

Page 12

Art Unit: 2176

James H. Blackwell

08/20/2007

*/Doug Hutton/*

Supervisory Primary Examiner  
Technology Center 2100